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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/056,831

01/24/2002

John R. Brustad

A-2207-AL

3412

21378

7590

12/01/2006

APPLIED MEDICAL RESOURCES CORPORATION

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EXAMINER

MENDEZ, MANUEL A

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

6

<b>Office Action Summary</b>	<b>Application No.</b> 10/056,831	<b>Applicant(s)</b> BRUSTAD, JOHN R.	
	<b>Examiner</b> Manuel Mendez	<b>Art Unit</b> 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 08 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Amendment***

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. The examiner erred by not including an inherency argument in the last office action. Moreover, a secondary search produced evidence that is considered pertinent to the prosecution of this application. Examiner invites applicant to respond to the following rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Yoon (5,389,080), Yoon (5,441,486), Gravener, et al., (5,360,417), or Hermann, et al.,** as discussed in the previous office action, and in further view of Yoon (5,814,026) or Yoon (5,788,676).

The applicant argues in the "Remarks" of his last correspondence that "[t]he gel material is unique in having floating or off-axis movement properties relative to the axis to maintain a seal with a surgical instrument even when the surgical instrument is inserted or moved laterally from the axis". However, the claim language does not specify any particular characteristic(s) of the gel utilized in the invention to produce the alleged "floating or off-axis movement properties". Accordingly, the examiner of record

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argues that the gels used by the apparatuses of the cited patents would inherently provide similar floating or off-axis movement properties.

Finally, the examiner presents **Yoon** (5,788,676) to demonstrate the use of multiple gel seals when a surgical instrument is inserted in the trocar. As figure 6 clearly shows, lumen (74) is wider than the diameter of tubular instrument (I). Therefore, in order for the apparatus to operate properly, the gel seals created by the valve must have "floating or off-axis movement properties" to compensate for lateral movement of the instrument (I).

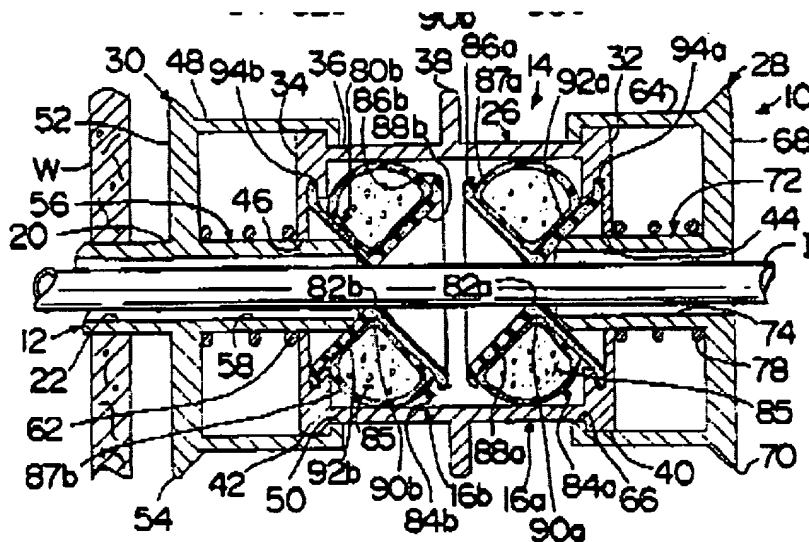
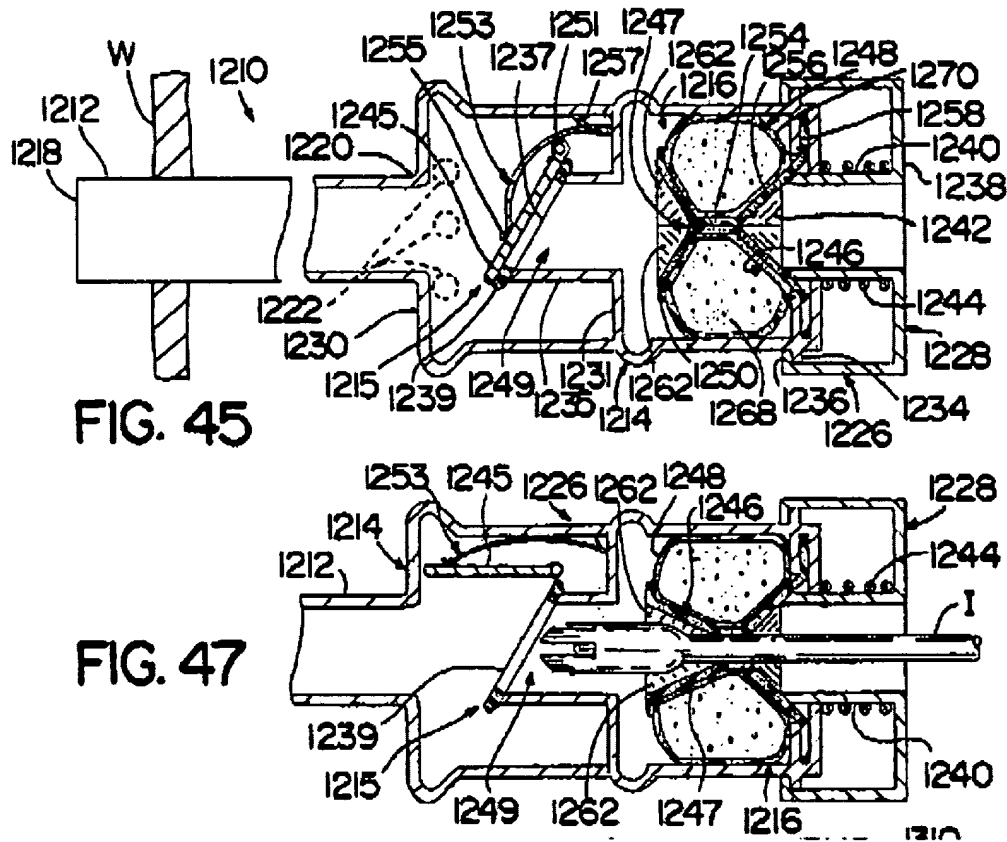


FIG. 6

Moreover, **Yoon** (5,814,026) demonstrates the conventionality of using a flapper valve to create an additional seal when instrument (I) is removed from the trocar. Figures 45 and 47 below illustrate the use of a flapper valve (1245) in combination with a gel valve.



Based on the above observations, for a person of ordinary skill in the art, modifying the apparatuses of any of the base references with multiple gel valves creating a first and a secondary seals as taught by Yoon (5,788,676), and with the use of a flapper valve in combination with a gel valve to create a seal when the tubular instrument is removed from a trocar as taught by Yoon (5,814,026), would have been considered obvious in view of the proven conventionality of these enhancements.

## Conclusion

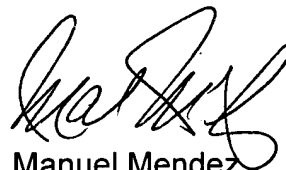
In view of the inherency argument and the new references included in the above rejection, this action is not a final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manuel Mendez whose

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telephone number is 703-272-4977. The examiner can normally be reached on 0730-1800 hrs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Nicholas D. Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Manuel Mendez  
Primary Examiner  
Art Unit 3763

MM